



Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0651-00xx
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

LWEP:119US

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on August 29, 2005

Signature

Typed or printed C. Paul Maliszewski
name _____

Application Number

10/605,492

Filed

Oct. 2, 2003

First Named Inventor

Ralf Krueger

Art Unit

2872

Examiner

Joshua L. Pritchett

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

 applicant/inventor. assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96) attorney or agent of record. 51,990

Registration number _____

Signature

C. Paul Maliszewski

Typed or printed name

716-626-1564

Telephone number

 attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

August 29, 2005

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



Attorney Docket No. LWEP:119US
U.S. Patent Application No. 10/605,492
Reply to Office Action of May 27, 2005
Date: August 29, 2005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

U.S. Patent Application No.: 10/605,492

Confirmation No.: 2491

Applicant(s): KRUEGER, Ralf

For: **PHASE SHIFT METHOD AND APPARATUS FOR
IMPLEMENTING PHASE-CONTRAST OR MODULATION-CONTRAST
OBSERVATION ON MICROSCOPES**

Filed: October 2, 2003

TC/Art Unit: 2872

Examiner: Joshua L. PRITCHETT

Docket No.: LWEP:119US

Customer No.: 24041

Certificate of Mailing by First Class Mail

I certify that this communication is being deposited on August 29, 2005 with the U.S. Postal Service as first class mail under 37 C.F.R. §1.8 and is addressed to the Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450.



C. Paul Maliszewski
Regis. No. 51,990

PRE-APPEAL BRIEF REQUEST FOR REVIEW WITH ARGUMENTS

Mail Stop AF
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Honorable Sir:

This is a reply to the Office Action dated May 27, 2005 and the Advisory Action dated August 5, 2005 regarding the above-identified patent application.

Remarks/Arguments begin on page 2 of this paper.

Remarks/Arguments

Rejection of Claims 1-3, 8-10, and 13 under 35 U.S.C. §103(a)

The Examiner rejected claims 1-3, 8-10, and 13 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,200,354 (Hoffman) in view of U.S. Published Patent Application No. 2003/013294 (Wolleschensky).

Applicant submits that the Examiner has omitted essential elements required to establish a *prima facie* rejection. “First, there must be some suggestion or motivation to modify the reference....The teaching or suggestion to make the combined combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure.” *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

a) Wolleschensky teaches away from the present invention:

In the Response to Arguments in the Advisory Action dated August 5, 2005 (hereinafter referred to as the Advisory Action), the Examiner stated that Wolleschensky does not teach against the present invention. The citation referenced in the Applicant’s Reply dated July 27, 2005 (hereinafter referred to as the Reply) is not with respect to how references are combined. Rather, “a *prima facie* case of obviousness can be rebutted if the applicant.... (2) can show ‘that the art in any material respect taught away’ from the claimed invention. *See In re Malagari* 499 F.2d at 1303, 182 USPQ at 553.” *See In re Geisler*, 43 U.S.P.Q. 2d 1362, 1366 (Fed. Cir. 1997). The present invention teaches a basic configuration for a modulator. Wolleschensky’s grating is structurally and functionally different from the above-mentioned configuration as shown on pages 3 and 4 of the Reply. In fact, the present invention would be unworkable with Wolleschensky’s grating.

b) Motivation to combine references:

As part of the above arguments in the Advisory Action regarding Wolleschensky teaching against the present invention, the Examiner further stated that the motivation to combine Hoffman and Wolleschensky was to reduce the amount of image aberration. However, Applicant can find no reference to this problem in either Hoffman or Wolleschensky. The

Examiner may not provide the motivation to combine references. “Hence, elements of separate patents cannot be combined when there is no suggestion of such combination in those patents.” *Panduit Corp. v. Dennison Manufacturing Co.*, 1 U.S.P.Q.2d 1593 (Fed. Cir. 1987).

In the Advisory Action, the Examiner stated Applicant’s arguments on pages 2 and 3 of the Reply regarding Hoffman and Wolleschensky solving different problems were not persuasive. Applicant submits that this is an overly broad application of the *prima facie* requirements. Common problem solution is an element of the motivation to combine references. Therefore, the disparateness of the problems addressed by Hoffman and Wolleschensky within the very broad field of microscopy is relevant.

In the Advisory Action, the Examiner stated Applicant’s arguments on pages 3 and 4 of the Reply regarding the functional and structural differences between Hoffman’s modulator and Wolleschensky’s grating were not persuasive. As noted above, the motivation to combine references must come from the references themselves. Assuming *arguendo* that Hoffman contained the motivation to modify his modulator to be tiltable, there must be a reason for Hoffman to consider Wolleschensky. Given the functional and structural differences between Hoffman’s modulator and Wolleschensky’s grate, Applicant maintains that the Examiner, not the references themselves, has provided this motivation.

Rejection of Claim 11 under 35 U.S.C. §103(a)

The Examiner rejected Claim 11 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,200,354 (Hoffman) in view of U.S. Published Patent Application No. 2004/0169925 (Dultz et al.).

Applicant submits that the Examiner has omitted substantially the same essential elements required to establish a *prima facie* rejection as shown *supra* for Claim 1.

In the Advisory Action, the Examiner stated that Applicant’s arguments on pages 4 and 5 of the Reply regarding Claim 11 and analogous art are not persuasive. Applicant submits that this is an overly broad application of the *prima facie* requirements. Common problem solution is an element of the motivation to combine references. Therefore, the disparateness of the

problems addressed by Hoffman and Dultz within the very broad field of light polarization is relevant.

Rejection of Claim 12 under 35 U.S.C. §103(a)

The Examiner rejected Claim 12 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,200,354 (Hoffman) in view of U.S. Patent No. 6,462,858 (MacDonald).

Applicant submits that the Examiner has omitted substantially the same essential elements required to establish a *prima facie* rejection as shown *supra* for Claim 1.

In the Advisory Action, the Examiner has stated that Applicant's arguments on page 6 of the Reply regarding MacDonald being nonanalogous are not persuasive. Applicant submits that this is an overly broad application of the *prima facie* requirements. Common problem solution is an element of the motivation to combine references. Therefore, the disparateness of the problems addressed by Hoffman and MacDonald within the very broad field of light polarization is relevant.

In the Advisory Action, the Examiner stated that Applicant's arguments on pages 6 and 7 of the Reply regarding multiple modulators are not persuasive. First, Applicant disagrees that each section of Hoffman's single modulator can reasonably be interpreted as a separate modulator (see pages 6 and 7 of the Reply). Second, Applicant maintains the argument presented on page 7 of the Reply that MacDonald's membrane is not analogous to multiple modulators (it is a single element, the shape of which is varied). Applicants disagrees with the definition of "mounted..on" as presented in the Advisory Action. The Merriam-Webster Dictionary defines mount as: "to attach to a support." In the Examiner's analogy, clearly the top box is not attached to the bottom box. As another analogy, a roof antenna is clearly not mounted to a basement floor despite the fact the roof to which the antenna is attached is eventually connected to the floor.

In the Advisory Action, the Examiner states that MacDonald does not teach against the present invention since MacDonald is used to teach a tiltable carrier. The citation referenced in the Reply is not with respect to how references are combined. Rather, "a *prima facie* case of

Attorney Docket No. LWEP:119US
U.S. Patent Application No. 10/605,492
Reply to Office Action of May 27, 2005
Date: August 29, 2005

obviousness can be rebutted if the applicant.... (2) can show 'that the art in any material respect taught away' from the claimed invention. *See In re Malagari* 499 F.2d at 1303, 182 USPQ at 553." See *In re Geisler*, 43 U.S.P.Q. 2d 1362, 1366 (Fed. Cir. 1997). MacDonald's invention does not work unless all the surfaces of the membrane are reflective. Assuming *arguendo* that the membrane is analogous to a present invention modulator, MacDonald clearly teaches against making any portion of the modulator non-reflective as recited in Claim 12.

Conclusion

Applicant respectfully submits that all pending claims are in condition for allowance, which action is courteously requested.

Respectfully submitted,



C. Paul Maliszewski
Registration No. 51,990
Simpson & Simpson, PLLC
5555 Main Street
Williamsville, NY 14221-5406
Telephone No. 716-626-1564

CPM/

Dated: August 29, 2005